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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/329,321 | 06/10/1999 | MARI KORKEA-AHO | 017.36935X00 | 7967 |
| 20457 | 7590 | 10/27/2004 | EXAMINER | |
| ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-9889 | | | THOMPSON, MARC D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2144 | |

DATE MAILED: 10/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/329,321 | KORKEA-AHO, MARI | |
| | Examiner | Art Unit | |
| | Marc D. Thompson | 2144 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 June 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1, 4, 6-13, 15-25, and 27-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,4,6-13,15-25 and 27-37 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 June 1999 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.
2. Applicant's submission filed on 6/29/2004 has been entered into record.
3. Claims 1, 4, 6-13, 15-25, and 27-37 remain pending.

Priority

4. No claim for priority has been made in this application.
5. The effective filing date for the subject matter defined in the pending claims in this application is 6/10/1999.

Drawings

6. The Examiner contends that the drawings submitted on 6/10/1999 are acceptable for examination proceedings.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 13-24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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8. Claim 13 recites “connected to network” in Line 4 of the claim. Since two networks are recited in the claim, it is unclear which network is being referred to. It is presumed “the” or the first “network” is being referenced in this section. All dependent claims relying on this claim for antecedent basis inherit this deficiency.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 4, 6-7, 12-13, 15-20, 25, 27-32, and 37 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Theimer et al. (U.S. Patent Number 5,555,376), hereinafter referred to as Theimer.

11. Theimer disclosed information available to user within a specific proximity to particular locations. See, *inter alia*, Abstract, and Column 4, Lines 7-12. Additionally, the use of access rights, locational information and policy management linking these two attributes was fully disclosed. See, *inter alia*, Column 4, Lines 43-50. Proximity to particular geographical points and the control of access to network resource(s) based on proximity and access right management was disclosed in numerous ways, including distance based querying of location(s) and propagation of network point of interest information. See, *inter alia*, minimally, Column 3, Lines 1-7, Column 18, Lines 24-41, and Column 19, Lines 19-27. The information available was varied and open to myriad potential types, specifically including location specific and related information. See, *inter alia*, Column 9, Lines 28-41. The disclosed terminal units were indeed,

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optionally, fully functional mobile terminals. See, *inter alia*, Column 6, Lines 48-65. The provision for multiple (sub) networks, where which physical or logical servers reside which provide access, location, and all other information types and values, was disclosed, *inter alia*, in Column 19, Lines 47-51. Since the provision for location and information reporting mechanisms were disclosed as agents, this explicitly provided “information and request supplied by a positional system”, as broadly claimed. See, *inter alia*, Column 4, Lines 19-29, and/or Column 19. The various specific fields of data within the location server, as claimed, was fully met by the Theimer teachings, *inter alia*, in Column 18. Clearly, “electronic documents” were optionally used to transmit information to client users. See, *inter alia*, Column 3, Lines 8-24. Provision for user entry of locational (and related) information was disclosed, *inter alia*, in Column 10, Lines 52-62.

12. Since the entirety of the limitations set forth in these broadly presented claims were specifically disclosed by Theimer, claims 1, 4, 6-7, 12-13, 15-20, 25, 27-32, and 37 are rejected.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(f) or (g) prior art under 35 U.S.C. §103(a).

15. Claims 1, 4, 6-13, 15-25, and 27-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLorme (U.S. Patent Number 5,848,373), hereinafter referred to as DeLorme, in view of Theimer et al. (U.S. Patent Number 5,555,376), hereinafter referred to as Theimer, and conversely, unpatentable over Theimer in view of DeLorme.

16. The details and mappings of the DeLorme teachings have been provided in prior action(s). The relevancy of these teachings have been well established, and remain, minimally, as previously set forth. The details of the prior mapping(s) of these teachings have not been argued by Applicant. Now, Applicant attempts to discern distinguishing features of the claimed invention as involving the incorporation of the use of access rights information and the use of this information for access regulation.

17. An artisan working with the DeLorme system would have been motivated to search the related arts for teachings relating to the storage and delivery of information between operating network terminals. This was evidenced, inter alia, in Column 3, Lines 55-67, where stated an object of the invention included provision to “provide communications of spatially related data between computer systems and between users in various combinations.”

18. In this art of location information relational database storage, retrieval, correlation, and information management, Theimer disclosed a system using mobile terminals accessing information using usage right management. Further, this information was available to users within proximity to particular locations. See, inter alia, Abstract, and above rejection.

19. The compatibility and combination of these teachings would have been obvious to one of ordinary skill in the art at the time the invention was made, minimally, for the reason provided

above; the correlation of two systems using positional information with an underlying network structure, a portion of the system using the CAMLS system set forth by DeLorme maintaining location information and events, combined with the physical proximity and access right management functionality set forth by Theimer, *inter alia*, in Column 4, Lines 46-50.

20. Conversely, the modification of the access rights and terminal proximity system set forth by Theimer with the system including CAMLS set forth by DeLorme would have been obvious, minimally, to have provided access to specific type(s) of information within the confines of the Theimer teachings. See, *inter alia*, Theimer, Column 4, Lines 7-29. Lastly, motivation existed to search for information sharing technology (*inter alia*, Theimer, Column 4, Lines 14-18), which was directly fulfilled by DeLorme, *inter alia*, in Column 17, Lines 38-64, and Column 44, Lines 18-45.

21. Since the combination of the Delorme and Theimer references disclosed all the claimed limitations, claims 1, 4, 6-13, 15-25, and 27-37 are rejected.

22. Claims 1, 4, 6-13, 15-25, and 27-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phelan et al. (Patent Number WO 97/07467), hereinafter referred to as Phelan, in view of Potmesil ("Maps alive: Viewing Geospatial Information on the WWW", Computer Networks and ISDN systems 29, 1997), hereinafter referred to as Potmesil, further in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made, further in view of Theimer et al. (U.S. Patent Number 5,555,376), hereinafter referred to as Theimer.

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23. Phelan disclosed a combined map and location information providing service available to mobile (handheld or laptop) computing units, optionally equipped with GPS to isolate current client terminal position, resulting in a system which queried database(s) and returned pertinent information to a requesting client user. See, *inter alia*, Abstract, Page 2, Line 30 through Page 3, Line 33. The system was further equipped with well known prior art HTML enabled information transport and display specifications. See, *inter alia*, Page 1, Line 26 through Page 2, Line 6.

24. While Phelan disclosed the invention substantially as claimed, Phelan did not specifically disclose the actual storage of locational information received from a client terminal. Phelan disclosed multiple databases containing geographically located data, including description, location, classification, and detailing information about points of interest on a map based interface. Thus, it was clear that this information was stored in digital form, and any artisan would realize this information was not random, and must have been a result of some form of storage, compilation, and indexing means, seemingly omitted from the teachings of Phelan. That is, Phelan remained silent as to the specifics of information storage, how the information was input into the database(s), and the specific equipment and/or methodology required to result in the system as described. Thus, an ordinary artisan would have been motivated to search the related portable terminal, web-based mapping and information delivery systems to find systems which fully describe the collection, posting, insertion, and indexing of the information within the databases which were utilized by Phelan.

25. In the same art of coordinating information with geographical locations, Potmesil disclosed the ability for client terminals to post geographically indexed information to databases used in a system which supplies information upon demand to geographically filtering requesting

clients. See *inter alia*, Section 1, Page 1327, and Section 2.3, Page 1330. Thus, given that the ordinary artisan understood how to construct functional web browsers which routinely accessed and manipulated information within database(s), the incorporation of the general teaching(s) of associating client user input with specific points on a given coordinate system was realized.

26. The incorporation of specifically identified fields, for example in claim 6, would have been obvious to one of ordinary skill in the art at the time the invention was made, since the teachings of Phelan and Potmesil directly alluded to use of such stored information in regular operation of the system. Database fields including position/geographical point information, ID and title/classification information, access rights for specified classes of users, (hyper)linked addressing information, date of creation information, etc., were well within the skill of one with ordinary knowledge in the field, and the result of processing of these fields was present in the combined teachings. Of course, the storage of all information came at a price: the consumption of memory. Given that the disclosed document, information, and map servers were little more than huge storage devices, it was a matter of design choice to incorporate these specific database fields. Of course, the more information which was available, the more versatile a searching system became. Thus, it would have been obvious to incorporate the various recited database fields set forth in the claim limitations, simply to provide more information for more versatility in filtering pertinent information.

27. Thus, the combination of Phelan, Potmesil, and the knowledge within scope of one with ordinary skill in the art at the time the invention was made would have made the invention obvious, resulting in a geographical locational mapping system, fully functional in a wide-area

network environment using HTML and HTTP, which supplied and gathered information related directly to geographical points for storage and filtering on remote network databases.

28. Lastly, the combination of Phelan and Potmesil did not expressly disclose the use of access right management for devices located within a proximity of a particular geographical location. An ordinary artisan would have been motivated to search for this particular function, since the information disclosed by this combination of teachings was clearly related to location, and information access and security was an inherent concern in information sharing systems at the time of invention.

29. In the related art of location information relational database storage, retrieval, correlation, and information management, Theimer disclosed a system using mobile terminals accessing information using usage right management. Further, this information was available to users within proximity to particular locations. See, *inter alia*, Abstract, and above rejection.

30. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Phelan and Potmesil with the access right management teachings set forth by Theimer in order to regulate information sharing to authorized, particular computer users. See, *inter alia*, Theimer, Column 4, Lines 43-50.

31. Claims 1, 4, 6-13, 15-25, and 27-37 are rejected.

Response to Arguments

32. The arguments presented by Applicant in the response received on 6/29/2004, are not considered persuasive.

33. Applicant argues the lacking of the prior art having taught or suggested the presence of access right information and management in the context of terminal services and information

available in fixed locations. It is submitted that this overly broad characterization is met, minimally, by Theimer.

34. Applicant makes spurious arguments relating to multiple networks. It is inherent that all devices on a particular network share a common network addressing scheme, i.e., a network level address. Since the provision for both wireline and wireless networks, which co-exist on the same network was provided (inter alia, Theimer, Columns 3-4), the provision for multiple (sub) networks was clearly met. This will not be considered a distinguishing factor for patentability in the present application.

35. In regard to Applicant arguments concerning HTML, Examiner remains firm on the well known state of this standard at the time of filing. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references through the use of HTML. Further, Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections if such consideration of the use of HTML is considered.

Conclusion

36. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc D. Thompson whose telephone number is 703-308-6750. The examiner can normally be reached on Monday-Friday, 9am-4pm. Note: The Examiner expects to move to the new PTO site in Carlyle in the next few months, and contact information will change at that time. If not available at the above number, The Examiner can be reached at 571-272-3932.

38. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski, Jr. can be reached on 703-308-3873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

39. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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